

REMARKS

Claims 29-35, 37-43, 45-51 and 53-58 are currently pending. Claims 29-33, 35, 37-38, 40-42, 45-46, 48-50, 53, 57, and 58 are amended. Reconsideration of the patentability of the claimed subject matter is requested in view of the foregoing amendments and following discussion.

§103 Rejections

Governing Legal Principles

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03.

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. 127 S. Ct. 1727 (2007)) to be “expansive and flexible” and “functional.” However, the standard is not controlling, rather, the various noted factors only “can” or “might” be indicative of obviousness based on the facts. The Supreme Court in KSR enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need “to guard against slipping into the use of hindsight,” acknowledged the following principles:

[r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in KSR stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. "Virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerasonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Supreme Court in KSR has also stated that:

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court states that:

The Court relied upon the corollary principle that when the prior art **teaches away** from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.

Discussion

- a) Claims 29, 30, 32-35, 38, 39, 41-43, 46, 47 and 49-51 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S Patent No. 5,796,397 to Kusano ('Kusano') in view of U.S. Patent No. 6,757,365 to Bogard ('Bogard').

Regarding claim 29, the Examiner first references the teaching in Kusano:

receiving a first user request to perform a task switch from a currently executing first program on the portable processing device.

The Examiner cites Kusano, at col. 2, lines 9-14 and lines 58-67 and col. 6, lines 4-7.

Attention is also directed to the following quotation in its entirety in Kusano, at col. 2, lines 9-14:

A primary object of the present invention is to provide an information processing device which is capable of easily changing a current application to another on a composite input screen with a menu of input items including selection of kinds of applications, whereby an input data item being inputted in one application mode is easily converted into..

This quote explicitly states that Kusano does not teach the method for the switching of applications, but rather teaches the following:

with a menu of input items including selection of kinds of applications, whereby an input data item being inputted in one application mode is easily converted into input data item for another application. and which is capable of effectively using input data which is common or equivalent for both applications by reflecting said data to the data content of the new application

Further, Kusano, at col. 2, lines 58-67 shows that it has no relevance to the present invention as claimed. Kusano, at col. 6, lines 4-7 additionally does not teach task switching but rather teaches choosing an application based on a dedicated button press. The Examiner then goes on to state the following:

Kusano does not specifically teach listing only ones of a plurality of programs installed on the portable processing device that are useful (Examiner's Interpretation of "ones" as "one or more" since the applicant failed to define nor preclude this limitation). However, Kusano disclosed input items that have no matching items in the new application could be re-used and data obtained by the switched application mode is applicable in a new application mode [col. 10, lines 24-27; col. 4, lines 29-34]. It would have been obvious to one of an ordinary skill in the art at the time

the invention was made, to have modified the teaching of Kusano to list only ones of a plurality of programs installed on the portable processing device that are useful to create a more efficient menu that avoid fruitless attempts that would yield non-matching items as implied by Kusano (i.e. not listing a clock, a calculator, etc. as displayed in Fig. 3 in the switch to application type of Fig. 7).

Applicants respectfully disagree with the Examiner regarding the above-quoted assertion. To teach the concept of limiting which applications are to be shown is not a trivial concept. It is particularly crucial to list useful applications. The Examiner indicates that Kusano teaches some aspects, allowing for information to be transmitted even if there are no corresponding fields for the data. However, Applicants do not see how this relates to the present invention because the present invention does not teach such a concept. Rather, “useful” has more to do with what applications a user might find “useful” in the use of another application. Applicant would like to direct the Examiner to Kusano, col. 2, lines 45-46, where the following text is stated:

*application mode is changed by using an application switching means.
input data stored in a buffer or data registered*

This text specifically states that Kusano does not teach “task switching.” The Examiner seems to agree with this as the Examiner states that “Kusano does not specifically teach context switching as recited.” The Examiner relies on Bogard to fill this void in Kusano. Examiner quotes a section from Bogard, in particular at col. 6, lines 53-63, for this purpose. The pertinent text is cited below:

Additionally, mechanisms for switching between running applications must be provided, this mechanism should allow preservation of state (where the user is, variables, dialogue point, etc.) when the user switches applications, e.g. to respond to an instant message or send an instant message. Similarly, one or more “universal” commands, dual-tone multi-frequency (DTMF), or switch hook signals, may be provided to switch the running application. For example, in one embodiment, the word “Message” might be recognized to switch to the messaging application while preserving state in the other application.

Applicants assert that from this text in Bogard, it is apparent that Bogard does not disclose the present invention, but rather, states requirements for a task switching system. Additionally, Applicants would like to point out that Bogard does not define how the state is preserved and does not state that it actually kills a program. Moreover, Bogard actually teaches away from this very aspect, by its teaching of “switching between running applications.” The present invention does not switch between “running” applications, but

rather, ends a currently running application and then executes another application that may be restarted to a previous state if it has an associated context packet.

The next cited references are meant to teach the act of “suspending” however, the claim has been amended to more accurately reflect the functionality of the present invention as the operation of suspending the applications as understood in the field, is simply not performed by the present invention. Therefore, the Examiner’s reference is moot. Further, the Applicants would like to bring to the Examiner’s attention to Bogard, at col. 7, lines 30-35:

*In some embodiments, the same universal command is used to toggle between the IM application and the other presently running application, e.g. "***", "##,! "00", "*IM", etc. According to this embodiment, the user can easily switch back and forth between the IM functionalities and her/his other activities on the voice portal 310.*

Applicants would like to specifically point out the term “running,” which is consistent with the above remarks and the use of the singular to describe “the other presently running application.” The claim has been further amended to emphasize that it is not meant to just function between two running applications. The Examiner may cite in Bogard, text appearing at col. 9, lines 11-20, to say that it teaches switching more than one application, however, the Applicants would like to point out that multiple “IM Sessions” are in fact the same application. Furthermore, Applicants would like to assert that the environment in which Bogard operates is very different. A server environment interfaced with a user through telephone as opposed to a personal computing device used in the present invention. Also, though Applicants do not see the combination proposed by the Examiner to be the result of logical reasoning, Bogard states it’s own interface for a specific application and environment. Applicants believe that there are significant elements in the present invention not taught by the prior art. Additionally, Bogard never teaches its actual method for storing state information as opposed to the innovative method proposed in the present invention of using context packets.

For these additional reasons, it is submitted that a *prima facie* case of obviousness based on *Kusano* and *Bogard* has not been properly established with respect to claim 29, which is therefore distinct from this combination and patentable. Because claims 30 and 32-35 depend from claim 29, they are likewise patentable over the references relied upon by the Examiner.

Independent claims 38 and 46 recite subject matter analogous to that of claim 29, therefore, it is respectfully submitted that they are likewise patentable over the references relied upon, as are their respective dependent claims 39, 41-43, 47 and 49-51.

The Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. §103(a) of claims 29, 30, 32-35, 38, 39, 41-43, 46, 47 and 49-51 .

b) Claims 31, 40, 48 and 57-58 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Kusano* in view of *Bogard* in further view of U.S. Patent No. 5,675,762 to Bodin et al. ('*Bodin*').

Claims 31, 40, and 48 depend on claims 29, 38, and 46, respectively, and are distinct at least for the same reasons by which claims 29, 38, and 46 are distinct. The distinctions with respect to claims 29, 38, and 46 are discussed above. Claims 57 and 58 recite a combination of limitations that are not met by a combination of *Kusano* and *Bogard* as indicated above. In addition, Bodin only discloses moving applications to the background without terminating them. A combination of *Kusano*, *Bogard* and Bodin still falls short of claims 57 and 58.

The Examiner is respectfully requested to withdraw the rejection of claims 31, 40, 48 and 57-58.

c) Claims 37, 45 and 53-56 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Kusano* in view *Bogard* in further view of U.S. Patent No. 6,061,711 to Song et al. ('*Song*').

Referring to claims 37, 45 and 53-56, Applicants are unsure where there is a teaching in either *Kusano* or *Bogard* regarding "efficiency in resource management." Applicant can find no evidence to support such a claim and the Examiner does not cite any references. Additionally, though the Examiner states that "applicant failed to defin[ed] what "a user" includes or excludes, therefore, an application programmer being a user clearly satisfied the limitation", Applicants contend that in the field, an Application Programmer is not termed a user, although a programmer may be a user at times. An Application Programmer, once defined as such, is a programmer and not a user and thereby has access to the source code and is allowed to make modifications to the program rather than through "user" selectable options. Additionally, neither *Kusano* nor *Bogard* teach the claimed invention.

Accordingly, because the cited references do not teach or suggest all of the features of claims 37, 45 and 53-56, Applicants respectfully submit that these claims are patentable over the references asserted.

Applicants respectfully request the Examiner to withdraw the rejections under 35 U.S.C. §103(a) of claims 37, 45 and 53-56.

CONCLUSION

Having addressed all the rejections and objections, Applicants respectfully submit that the subject application is in condition for allowance and a notice to that effect is earnestly solicited. In the event any outstanding issues remain, the Examiner is respectfully requested to contact the undersigned and to resolve them.

If necessary, the Commissioner for Patents is authorized to charge or credit the **Account No. 50-3102** for any deficiency or overpayment in connection with this submission.

Respectfully submitted,

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